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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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45962	7590	07/21/2009	EXAMINER	
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BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP			ART UNIT	
1279 OAKMEAD PARKWAY			PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/749,686

Applicant(s)

NIKOLOV ET AL.

Examiner

INSUN KANG

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47-61 is/are rejected.
- 7) ☒ Claim(s) 47-61 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 3/19/2009

DETAILED ACTION

1. This action is in response to the amendment filed on 3/19/2009.
2. Claims 47-61 are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 47-61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Per claim 47, it is unclear the relationship between "additional byte code instructions" included in lines 2-3 and the plug-in handler treatment in lines 23-24. What is the purpose of including additional byte code instructions? Interpretation: in the lines 1-2, modifying methods...entry and/or exit points to cause a plug-in handler to provide output function handler treatment for said methods. In the lines 23-24, ...plug-in to said invoking method...can receive appropriate output function handler treatment for said invoking method from said appropriate plug-in.

Per claims 52 and 57, these claims are rejected for the same reasons set forth in connection with the rejection of claim 47 above. Furthermore, per claim 57, it is unclear how the one or more processors can comprise the code recited in the claim body. Interpretation: in lines 2-3, "said one or more processors comprising" is interpreted as: "said program code to perform a method, said method comprising."

Per claims 48-51, 53-56, and 58-61, these claims are rejected based on dependency on the parent claims above.

Claim Objections

5. Claims 47-61 are objected to because of the following informalities: Per claims 47, 52, and 57, "class-file" appears to be changed to "class file." Per claim 59, it appears that "48" needs to be changed to "58." Per claims 48-51, 53-56, and 58-61, these claims are objected based on dependency on the parent claims above. Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 57-61 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 57-61 are non-statutory because they are directed to a "machine readable storage medium" that includes propagation media and communication media such as signals/carrier waves such as defined in the instant specification (i.e. 0164). Such a medium does not have a physical structure, rather it is the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism per se, and, thus, does not fit within the definition of the categories of patentable subject matter set forth in § 101. Therefore, the claims are non-statutory. Recommendation: delete the non-physical media to include only statutory media. Or, break the machine readable medium into different media such as: in line 3, "but is not limited to, machine readable tangible storage media (for example,

hard-disk drives...optical cards), propagation media, or other type...instructions." Therefore, claim 57 can recite, a "machine readable tangible storage medium" to refer to the physical media.

The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101. The following link on the World Wide Web is for the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101. [<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf>](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf)

Specification

8. The use of the trademark JAVA, ENTERPRISE JAVA BEAN/EJB, has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code in 0127, 0160. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 47-61 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 and 39-50 of copending Application No. 10/750160. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention (i.e. modifying the byte code, dispatching, plug-in treatment, method identification etc) and recites only obvious differences which would have been obvious to one of ordinary skill in the art of program development at the time of invention such as simply (i) omitting/adding steps or elements along with their functions, and/or (ii) implementing the method steps with means for performing the steps, for the purpose of expediting the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 47-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 7,426,723.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention (i.e. modifying the byte

code, dispatching, plug-in treatment, method identification etc) and recites only obvious differences which would have been obvious to one of ordinary skill in the art of program development at the time of invention such as simply (i) omitting/adding steps or elements along with their functions, and/or (ii) implementing the method steps with means for performing the steps, for the purpose of expediting the claimed invention.

13. Claims 47-61 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-10, 13-15, 22, 24, 26, 28, 30, 31, 43-45, and 47 of copending Application No. 10/749740. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention (i.e. modifying the byte code, dispatching, plug-in treatment, method identification etc) and recites only obvious differences which would have been obvious to one of ordinary skill in the art of program development at the time of invention such as simply (i) omitting/adding steps or elements along with their functions, and/or (ii) implementing the method steps with means for performing the steps, for the purpose of expediting the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 47-61 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-11, 13-28, 30-34 of copending Application No. 10/749617. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention (i.e. modifying the byte code, dispatching, plug-in treatment, method identification etc)

and recites only obvious differences which would have been obvious to one of ordinary skill in the art of program development at the time of invention such as simply (i) omitting/adding steps or elements along with their functions, and/or (ii) implementing the method steps with means for performing the steps, for the purpose of expediting the claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

15. Claims 47-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-46 of U.S. Patent No. 7,367,025.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to substantially the same invention (i.e. modifying the byte code, dispatching, plug-in treatment, method identification etc) and recites only obvious differences which would have been obvious to one of ordinary skill in the art of program development at the time of invention such as simply (i) omitting/adding steps or elements along with their functions, and/or (ii) implementing the method steps with means for performing the steps, for the purpose of expediting the claimed invention.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to INSUN KANG whose telephone number is (571)272-3724. The examiner can normally be reached on M-R 7:30-6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis A. Bullock, Jr. can be reached on 571-272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information

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regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Insun Kang/

Primary Examiner, Art Unit 2193